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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,769	12/21/2001	Sandrine Decoster	05725.0993	2464

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EXAMINER

YU, GINA C

ART UNIT PAPER NUMBER

1617

DATE MAILED: 05/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/018,769

Applicant(s)

DECOSTER ET AL.

Examiner

Gina C. Yu

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 18,20-28 and 30-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18,20-28 and 30-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

Receipt is acknowledged of amendment filed on February 10, 2006. Claims 18, 20-28, and 30-51 are pending. The substance of the claim rejection made under 35 U.S.C. § 103 (a) as indicated in the previous Office action dated August 11, 2005 is maintained for the reasons of record.

#### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 18, 20-28, and 30-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsumatsu et al. (WO 99/13830) ("Mitsumatsu") in view of Sebag et al. (WO 98/03155) ("Sebag").**

Mitsumatsu teaches shampoo formulations comprising trizole, an optical brightener, and either stearyl alcohol or behenyl alcohol. See Examples 3-5. Detergent surfactants such as ammonium lauryl sulfate and cocamidopropylbetaine are used within the claimed amount. See instant claims 37-39. Conditioning agents such as silicone emulsion are used. See instant claims 40-44. See p. 45, lines 9 – 14 for the method of use. See instant claims 49-51.

While the example formulations do not concurrently use stearyl alcohol and behenyl alcohol within a same composition as recited in the instant claims, the Mitsumatsu patent suggests using cetyl alcohol, stearyl, behenyl alcohol, and mixtures thereof. See p. 24, lines 16 – 20. These compounds, collectively named as "high melting point compounds" in the reference, are said to cover the hair surface and

reduce friction, providing smooth feel and easy combing. See p. 23, line 31 – p. 24, line 15. The Example formulation 4 and 5 shows concurrent use of cetyl alcohol and stearyl alcohol in the ratio of 1:1 and 1:2, which renders the use of stearyl alcohol and behenyl alcohol within the claimed range obvious. See instant claims 18, 47, 49, 50, and 32 – 34.

For instant claims 26-31, while the Mitsumatsu Examples do not show the recited weight range of the fatty alcohols, examiner notes that generally, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. See MPEP § 2144.05. Since the general conditions of the instant claims are disclosed in Mitsumatsu, examiner views that one having ordinary skill in the art would have discovered the optimum or workable ranges by routine experimentation. Raising the concentration of an active component to enhance the effect of the “high melting point compounds” would have been obvious to the routineer.

Mitsumatsu, discussed above, fails to teach the opacifier/pearlescent recited in claims 19-25.

Sebag teaches hair washing and conditioning compositions comprising a dialkyl ether of formula (II) in instant claim 22, and preferably distearyl ether. See English equivalent of Sebag, US 6162423, col. 2, lines 26 – 53; col. 1, lines 4- 66. The reference teaches that the use of at least one fatty dialkyl ether used in the instant invention renders a washing foaming compositions having insoluble silicones and surfactants, pearlescent effect, good homogeneity, and improved stability while

maintaining foaming power. See Example 1, which comprises 4 % by weight of stearyl ether and 1 % by weight of cetylstearyl alcohol.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the shampoo compositions comprising silicone emulsion in Mitsumatsu by adding distearyl ether in the composition as motivated by Sebag, because the latter teaches that the compound renders insoluble silicone and detergent-containing foam compositions pearlescent effect, good homogeneity, and improved stability while maintaining foaming effect. The skilled artisan would have had a reasonable expectation of successfully producing silicone-containing shampoo compositions with pearlescent effect, good homogeneity with improved stability and foams.

### ***Response to Arguments***

Applicant's arguments filed February 10, 2006 have been fully considered but are unpersuasive.

While applicant point out the deficiencies of each references that already have acknowledged and considered by the examiner, examiner views that a more relevant issue is whether or not a skilled artisan would have been motivated to make the present invention in view of the combined teachings of the references.

The amended weight ratio of the fatty alcohols is still met by the teaching of Mitsumatsu, as discussed above.

In citing Mitsumatsu, examiner has cited the motivation to combine stearyl alcohol and behenyl alcohols. The reference teaches that the fatty alcohols used in the

example and behenyl alcohols similarly “reduce friction, providing smooth feel and easy combing”. See p. 23, line 31 – p. 24, line 15. Applicants have not responded why, in view of this explicit suggestion that these fatty alcohols are functional equivalents, concurrently using stearyl alcohol and behenyl alcohols as applicants have done should overcome the obviousness rejection.

Applicants’ state, “examiner’s reliance on example 4 and 5 of Mitsumatsu fails to take into account the fact that the amount of stearyl alcohol, used in these examples is less than the claimed amount”. The argument is unpersuasive because adding 0.2 % of stearyl alcohol and 0.1% of behenyl alcohol would constitute 0.3 % of fatty alcohols, which meets the claimed limitation. Adding 0.1 % of behenyl alcohol would have been obvious to the routineer because Example 3 uses that amount, and Example 6 illustrates combining 0.1 % of cetearyl alcohol with 0.2 % of stearyl alcohol. Again, applicant is reminded that the present rejection is not made under anticipation standard but obviousness standard.

Applicants also assert, “examiner’s reliance on the cetyl alcohol/stearyl alcohol ratio in Examples 4 and 5 of Mitsumatsu as the modification to substitute behenyl alcohol for cetyl alcohol ignores the fact that such substitution will still not result in a composition as recited in the independent claims”. The argument is unsupported. The claimed limitation on the weight amount of the fatty alcohols is not directed to the amount of stearyl alcohol alone. The limitation is the sum of the fatty alcohols that are concurrently used in the composition. Applicants’ assertion that “the amount of stearyl alcohol is outside the scope of the present claims” is not well taken. Examiner views

that summing the amount of the fatty alcohols as exemplified in the disclosure only requires an ordinary skill in the art, rather than specific disclosure or guidance as applicants assert is missing from the Mitsumatsu reference.

Applicants also argue that there is no motivation to combine the optical brighteners of Mitsumatsu and the opacifiers/pearlescent agents of Sebag, simply because these agents “differ in mechanism and function”. The argument is unpersuasive. The present rejection is not based on any assumption that these agents somehow have same functions. It is well settled in patent law that the strongest rationale for combining references is a recognition, expressly or impliedly in the prior art or drawn from a convincing line of reasoning based on established scientific principles or legal precedent, that some advantage or expected beneficial result would have been produced by their combination. See In re Sernaker, 702 F.2d 989, 994-95, 217 USPQ 1, 5-6 (Fed. Cir. 1983). In this case, the cited motivation to combine the reference is that, since the references teach that these agents have been used in hair care products for the specific cosmetic benefits, and the skilled artisan would have expected that combining the teachings of the references would result in a composition comprising both optical brightening and pearlescent effects. Examiner asserts that a prima facie case of obviousness has been established in this case, and maintains the rejection.

### ***Conclusion***

No claims are allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

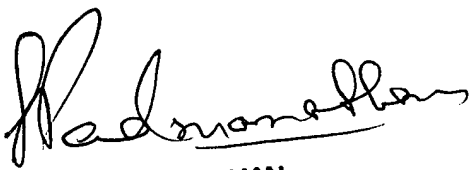
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-8605. The examiner can normally be reached on Monday through Friday, from 9:00AM until 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu  
Patent Examiner



**SREENI PADMANABHAN**  
**SUPERVISORY PATENT EXAMINER**